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09/981,556	10/17/2001	Arnold G. Slezak	P1535US01	6786

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EXAMINER
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TUGBANG, ANTHONY D

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3729

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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Attachment to Advisory Action

The applicant(s) arguments in their last response (filed on April 26, 2010) have been fully considered, but they have not been deemed to be found as persuasive.

112, First Paragraph

The applicant(s) first assert that the 112, 1<sup>st</sup> paragraph rejections should be withdrawn because the applicant(s) disclosure states that the discs, with alignment marks, orients the alignment marks *oppositely* for even numbered discs and *at even intervals* for odd numbered discs in the stack, and that these phrases (in emphasis above) clearly mean “symmetrical”.

The examiner disagrees with this assertion. Orienting the discs *oppositely* and *at even intervals* does not imply symmetrical in terms of the claimed “alignment axis” or “alignment axes”. The applicant(s) description of their invention (on pages 10 through 12 of their last response) is in terms of alignment marks. However, the claims never describe the invention in terms of alignment marks. The claims recite “a direction of an alignment axis that is in the same direction for the all of the plurality of the prewritten discs in relation to a center of the respective prewritten disc” (lines 3-5 of Claim 1) and “alignment axes...” (lines 6-8 of Claim 1). The “alignment axis” of the claims does not correlate to any of the alignment marks of the disclosure. The Board (pages 4-5 of the BPAI decision, dated August 31, 2009) had concerns with this issue in terms of a “common angular reference axis”, where they specifically stated:

The claims are directed to a process of placing prewritten discs having servo tracks that are "offset in relation to a common angular reference axis of each disc" around a motor hub. The prewritten discs are placed with respect to each other "disposing the angular reference axes around the motor hub" and biasing each disc in a direction of the respective angular reference axis to concentrically align the servo tracks of the prewritten discs.

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The Specification describes a process placing a prewritten disc about the spindle motor hub of a disc drive. A detector scans the prewritten disc to locate the alignment mark. The prewritten disc is then rotated and aligned with the assistance of a biasing force that is applied to the outside edge of the disc toward its center. The position of the prewritten disc is then secured to the spindle by a disc clamp. The process continues by placing the next prewritten disc about the spindle and balancing the disc stack by applying the biasing forces in other directions that are dependent on the number of discs which will form the assembly.

A person having ordinary skill in the art would not understand what is claimed when claims are read in light of the Specification. The claims recite the prewritten discs have servo tracks that are "are offset in relation to a common angular reference axis of each disc" and the discs are placed "disposing the angular reference axes symmetrically around" the motor hub. The Specification describes a process of locating an alignment mark on a prewritten disc and rotating and aligning the prewritten disc with a biasing force in a direction toward the center of the disc. The Specification does not describe the Appellant's invention in terms of a "common angular reference axis," and a person of ordinary skill in the art would not understand what axis is being referred to. For example, "common angular reference axis" could refer to a common cylindrical axis (viewing Figure 2, an axis radiating through the page), a polar axis (viewing Figure 2, an axis that rotates around the disc like a hand of a clock) or a common rectangular axis lying in the plane of the page on which Figure 2 appears, and the Specification does not provide adequate guidance to as the proper coordinate system to use to place this claimed phrase in context. As such, a person of ordinary skill in the art would not understand the scope of the claims in light of the Specification because the claims terms are not sufficiently described in the Specification.

Accordingly, the scope of meaning of the claims is undeterminable, subject to plural interpretations, and therefore indefinite. Furthermore, the notice requirement of 35 U.S.C. § 112, second paragraph, appears not to have been met to permit the public to reasonably avoid potential infringement of any claim that may be issued. Moreover, the claims, as drafted, fail to provide a clear measure of what Appellant regards as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the Specification meets the criteria of 35 U.S.C. § 112, first paragraph, with respect to the claimed invention.

The examiner's position is that the Board's analysis still applies in terms of the claimed "direction of an alignment axis that is in the same direction for the all of the plurality of the

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prewritten discs in relation to a center of the respective prewritten disc”, particularly since this alignment axis can be read as one that radiates into or out of, or through, the page (as in applicant(s) Fig. 2).

Therefore, the 112, first paragraph rejections are maintained because the specification never recites the term of “symmetrically” and because the terms *oppositely* and *at even intervals* as far as the orientation of the discs, do not positively mean *symmetrically*.

#### 112, Second Paragraph

The examiner’s arguments are repeated from above as to the correlation of the claimed “alignment axis” and disclosed “alignment marks” and the differences between the two. While the examiner understands that the applicant(s) are entitled to a broader scope of claims to encompass all of their disclosed embodiments, the applicant(s) are not entitled to a scope that is subject to plural interpretations that would contradict the specification, or is not described sufficiently by the specification.

For example, the applicant(s) strenuously assert that Claim 1 describes the “alignment axis” as being *within the same plane* of the disc (p. 16 of last response). This is simply not true and here lies the problem. First, the claims never recite “the same plane of the disc”. Second, to describe the alignment axis as being “in the same angular direction for all of the plurality of prewritten discs in relation to a center of the respective prewritten disc, around a motor hub”, is not the same thing as saying that the alignment axis are “in the same plane of the disc”. The claimed alignment axis as it relates the center of the disc, can be read as some “angular direction” perpendicular to the plane of the disc, or at some angle from each plane of the disc.

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Because of this confusion as to the interpretation of the claim language, the 112, second paragraph rejections are maintained.